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FIRST NAMED INVENTOR ATTORNEY DOCKET NO. CONFIRMATI APPLICATION NO. FILING DATE 09/830,721 04/30/2001 Klaus G. Schmitt GER5272

7590

09/25/2003

Edward D Murphy The Black & Decker Corporation 701 East Joppa Road TW199 Towson, MD 21286

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EXAMINER		
SAETHER, FLEMMING		
ART UNIT	PAPER NUMBER	

ART UNIT 3679

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application N .	Applicant(s)	
Office Action Summary	09/830,721	SCHMITT ET AL.	
	Examiner	Art Unit	
<u> </u>	Flemming Saether	3679	
The MAILING DATE of this communication appears on the cover sheet with the correspond nce address Period for Reply			
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).  - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).  Status			
1) Responsive to communication(s) filed on 22 A	lugust 2003 .		
2a) ☐ This action is <b>FINAL</b> . 2b) ☑ Thi	s action is non-final.		
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims			
4)⊠ Claim(s) <u>20-38</u> is/are pending in the application.			
4a) Of the above claim(s) is/are withdrawn from consideration.			
5) Claim(s) is/are allowed.			
6) Claim(s) is/are rejected.			
7) Claim(s) is/are objected to.			
8) Claim(s) <u>20-38</u> are subject to restriction and/or election requirement.			
Application Papers			
9)☐ The specification is objected to by the Examiner.			
10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.			
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).			
11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved by the Examiner.			
If approved, corrected drawings are required in reply to this Office action.			
12) The oath or declaration is objected to by the Examiner.			
Priority under 35 U.S.C. §§ 119 and 120			
13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).			
a) ☐ All b) ☐ Some * c) ☐ None of:			
1. Certified copies of the priority documents have been received.			
2. Certified copies of the priority documents have been received in Application No			
<ul> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>			
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).			
<ul> <li>a) ☐ The translation of the foreign language provisional application has been received.</li> <li>15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.</li> </ul>			
Attachment(s)			
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s)	5) Notice of Informal i	y (PTO-413) Paper No(s) Patent Application (PTO-152)	
S. Patent and Trademark Office			

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 20-24, drawn to a stud, classified in class 411, subclass 171.
- II. Claims 25-38, drawn to a method of welding, classified in class 219.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product could be used without arc welding.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

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or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 703-308-0182. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on 703-308-1159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

Flemming Saether Primary Examiner

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